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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,520	02/12/2004	Steven P. Bitler	14311-1	6983
<div>7590 Jeffrey G. Sheldon Esq. Sheldon & Mak Suite 900 225 South Lake Avenue Pasadena, CA 91101</div>			<div>EXAMINER FERGUSON, LAWRENCE D</div>	
			<div>ART UNIT 1774</div>	<div>PAPER NUMBER</div>
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/777,520

Applicant(s)

BITLER ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed December 4, 2006.

Claims 1 and 12 were amended rendering claims 1-20 pending.

Claim Rejections – 35 USC § 102(b)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 8 (JP 8-311716A).

JP 8 discloses a bicomponent fiber or composite fiber comprising a first polymeric composition comprising polyolefin and paraffin wax having a melting temperature of greater to or equal than 80°C and a heat of fusion greater than or equal to 30m/mg and a second polymeric composition overlapping the first component (abstract). Because JP 8 discloses an article comprising a first component composed of a first polymeric composition having a melting point which is at least -40°C and at most 100°C and a second polymeric component overlapping the first composition, it is inherent for the article to possess the same onset melting temperature, volume

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expansion, cross section and shape capabilities due to having the same structural identity as claimed. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Regarding claim 20, which is a product by process claim, the invention defined by claim 20 is a multi-component fiber, which is met by JP 8. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In *re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

Claim Rejections – 35 USC 102(e)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Clark et al (U.S. 6,723,669).

Clark discloses an extruded multicomponent fiber comprising a first crystalline olefin polymeric component and second amorphous olefin polymeric component having a continuous cross section throughout its length (column 2, lines 8-30; column 3, lines 12-20 and column 8, lines 51-55) where the amorphous polymer has a lower degree of crystallinity (column 5, lines 65-67). Clark further discloses the multicomponent fibers can vary as desired, vary in shape and can be positioned in a side-by-side arrangement or sheath/core arrangement (column 3, lines 30-40 and 52-55) where the polymers can be arranged in polyolefin/polyamide; polyolefin/polyolefin or polyolefin/polyester arrangement (column 4, lines 58-60). The first component has a heat of fusion ranging from 1-18) where the first and second components having good stretch and recovery characteristics (column 6, lines 55-60). The material is woven fabric (yarn) (column 11, lines 59-62 and column 12, lines 5-6) which can be used in garments such as pants or shirts (column 15, lines 47-52). Because Clark discloses an article comprising a first component composed of a first polymeric composition having a melting point which is at least -40°C and at most 100°C and a second polymeric component overlapping the first composition, it is inherent for the article to possess the same onset melting temperature, volume expansion, cross section and shape capabilities due to having the same structural identity as claimed. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere

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recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art.

Regarding claim 20, which is a product by process claim, the invention defined by claim 20 is a multi-component fiber, which is met by Clark. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

Response to Arguments

6. Rejection made under 35 U.S.C. 112, first paragraph, is withdrawn due to Applicant's arguments.

Applicant's arguments to the rejection made under 35 U.S.C. 102(b) as being anticipated by JP 8 (JP 8-311716A) has been considered but is unpersuasive. Applicant argues JP 8 does not disclose a crystalline polymer. JP 8 discloses a first component comprising polyolefin with a melting temperature, which is at least -40°C and at most 100°C . Because the first component has the same material and melting point as claimed, it is expected for the polymeric material to be crystalline. Applicant argues that JP 8 does not inherently have the claimed melting temperatures and onset of melting temperatures. Because JP 8 discloses an article comprising a first component composed of a first polymeric composition having a melting point which is at least -40°C

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and at most 100°C and a second polymeric component overlapping the first composition, it is inherent for the article to possess the same onset melting temperature, volume expansion, cross section and shape capabilities due to having the same structural identity as claimed. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Applicant has presented no showing that JP 8 cannot inherently show these claimed features. Applicant has further argued that the thermoplastic cover prevents shape changing during heating and cooling of the inner components. Examiner is not persuaded by Applicant's argument because JP 8 does not teach the polymeric overlapping component prevents shape changing during heating and cooling of the inner components. Additionally, in claims 1 and 12, the phrases, "when it is heated from T_o to T_p and when it is cooled from T_p to T_o " and "article, in the absence of external restraint, changes shape when it is heated from T_o to T_p and when it is cooled from T_p to T_o " constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Applicant's arguments to the rejection made under 35 U.S.C. 102(e) as being anticipated by Clark et al (U.S. 6,723,669) has been considered but is unpersuasive. Applicant argues Clark does not teach the article having a temperature dependent shape. In claims 1 and 12, the phrases, "when it is heated from T_o to T_p and when it is cooled from T_p to T_o " and "article, in the absence of external restraint, changes shape

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when it is heated from T_o to T_p and when it is cooled from T_p to T_o ” constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform.

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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